

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.116, and in light of the remarks which follow, are respectfully requested.

Claim 1 has been amended to incorporate therein the subject matter of claim 2. Claim 2 has been canceled without prejudice or disclaimer. No new matter has been added. Applicants respectfully submit that entry of the foregoing amendments, after final rejection, is proper at least because they place the application either in condition for allowance or in better form for appeal. See M.P.E.P. § 714.12.

Upon entry of the Amendment, claims 1 and 3-10 will be all the claims pending in the application.

I. Response to Rejections under 35 U.S.C. § 102(b)

a. Claims 1-10 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Japanese Patent Document No. 08-269392 (Niwa et al. '392).

b. Claims 1-6, 8 and 10 have been rejected under § 102(b) as allegedly being anticipated by Japanese Patent Document No. JP 08-231938 (Niwa et al. '938).

c. Claims 1-4, 7 and 9 have been rejected under § 102(b) as allegedly being anticipated by Japanese Patent Document No. JP 08-218296 (Niwa et al. '296).

Applicants respectfully submit that the present claims as amended are novel over Niwa et al. '392, Niwa et al. '938, and Niwa et al. '296 for at least the following reasons.

Independent claim 1 recites a cationic polymerizable resin composition comprising (A) a compound having at least one functional group capable of cationic ring-opening polymerization and (B) a cationic polymerization initiator to generate active species by electromagnetic wave or particle beam, which further comprises (C) a compound to generate a carbocation by the action

of the active species generated from (B) the cationic polymerization initiator by electromagnetic wave or particle beam, in an amount of 0.01 to 10.0 % by weight based on 100 % by weight of the sum of the components (A) and (C), wherein the composition does not contain an epoxy compound, and wherein the component (B) is contained in an amount of 0.5 to 10.0 parts by weight based on 100 parts by weight of the sum of the components (A) and (C).

As described in paragraph [0022] of the present specification, the component (C) is activated by the cationic polymerization initiator (B) and thereby the polymerization is accelerated. The presently recited composition having the specified ratios of components (A), (B) and (C) can realize both curability and transparency, as shown in the Declaration by Mr. Ito previously submitted on April 14, 2008.

Furthermore, as described in paragraphs [0027]-[0028] of the present specification, the composition ratios of components (A), (B) and (C) as defined in claim 1 can provide sufficient curability. Moreover, a decrease in water resistance or coloration of the resins do not occur in practical applications. As such, the composition recited in claim 1 is suitable for use in applications such as a sealing agent, an adhesive, a painting material, a coating material, an ink and a sealing material as defined in claims 5 to 10.

1. Niwa et al. '392

The Office Action asserts that applicant's 0.01 to 10% by weight of component (C) is encompassed in the range taught by Niwa et al. '392 and thus anticipated. The Office Action further asserts that one of ordinary skill in the art would have expected good light transmittance in the cured product comprising the mixture of an oxetane and a vinyl ether because it is known in the optical fiber art that yellowing of the cured coating caused problems in attenuation, and thus the invention is anticipated by the reference. See page 3, paragraph 8 of the Office Action.

Niwa et al. '392 teaches in paragraph [0058] that the photo cation polymerization initiator (which may correspond to the component (B) recited in present claim 1) is contained preferably in an amount of 0.1 to 20 wt%, more preferably 0.1 to 10 wt% based on the total amounts of a compound having an oxetane ring and a compound having a vinyl ether group. When the amount is less than 0.1 wt%, the curability is insufficient, on one hand, when the amount exceeds 20 wt%, the light transmittance is poor and uniform curing cannot be attained, and the coating has sometimes no surface smoothness.

As the Examiner pointed out, Niwa et al. '392 teaches that the amount of component (C) is broadly in the range of 5-95 parts based on the total amounts of the components (A) and (C) of 100 parts (See paragraph [0065]).

Examples of Niwa et al. '392 use the component (C) as large as 25 wt% and 75 wt%. However, these results therein showed that even when the component (C) is added in such larger amounts than the claimed upper limit of 10 wt%, the compositions still can be cured without causing problems, such that the light transmittance is poor and uniform curing cannot be attained.

On the other hand, the previously submitted Declaration clearly showed that when the component (C) was used in an amount exceeding the presently claimed upper limit of 10.0 wt%, the coloration state becomes worse (Examples 7 and 8 and Comparative Examples 4 and 5). The coloring state and the light transmittance mentioned in Niwa et al. '392 are different in their evaluation criteria and thus should be distinguished from each other.

In addition, Niwa et al. '392 is silent on the relation between the transparency and the amount of component (C), and therefore, fails to provide any motivation to one of ordinary skill in the art to decrease the amount of the component (C) in order to improve coloring state (transparency).

Thus, the combination effects of good coloring state and good curability attainable by the presently claimed invention are unexpected results and cannot be easily attained by one of ordinary skill in the art, in view of the disclosure of Niwa et al. '392.

2. Niwa et al. '938

The Office Action asserts that Niwa et al. '938 teaches that the compositions have good appearance and thus the invention is anticipated thereby. See paragraph 10 bridging pages 3 and 4 of the Office Action.

Similar to Niwa et al. '392, Niwa et al. '938 teaches that the amount of component (C) is broadly in the range of 5-95 parts based on the total amounts of the components (A) and (C). The previously submitted Declaration demonstrated the criticality of the amount of component (C) in the compositions in providing good coloring state (Examples 1-6 and 9-16 vs. Examples 7 and 8 and Comparative Examples 4 and 5).

3. Niwa et al. '296

The Office Action asserts that Niwa et al. '296 teaches that the compositions have good gloss and thus the invention is anticipated thereby. See page 4, paragraph 12 of the Office Action.

Similar to Niwa et al. '392, Niwa et al. '296 teaches that the amount of component (C) is broadly in the range of 5-95 parts based on the total amounts of the components (A) and (C). The previously submitted Declaration demonstrated the criticality of the amount of component (C) in the compositions in providing good coloring state (Examples 1-6 and 9-16 vs. Examples 7 and 8 and Comparative Examples 4 and 5).

In view of the foregoing, Applicants respectfully submit that present claim 1 is not anticipated or rendered obvious by Niwa et al. '392, Niwa et al. '938, and Niwa et al. '296, and

thus the rejections should be withdrawn. Additionally, claims 3-10 depend from claim 1 and thus are patentable over the cited references at least by virtue of their dependency.

II. Conclusion

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (202) 452-7932 at his earliest convenience.

Respectfully submitted,

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By: _____



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